Patent
Attorney's Docket No. 032592-003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	
Avram GLAZER	Group Art Unit: 2167
Application No.: 09/545,875	Examiner: Joseph A. Fischetti
Filed: April 7, 2000	Confirmation No.: 2172
For: SYSTEM OF CONSISTENT INTERNET WEB SITE BANNERS THAT PROVIDE PORTAL-LIKE FUNCTIONALITY	

REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Reconsideration and allowance of the present application are respectfully requested.

Applicant notes the indication on page 2 of the Office Action that affirmation of the election requirement is requested. Accordingly, election of claims 1-14 with traverse, is hereby acknowledged.

The Restriction Requirement is traversed because it is believed that in examining the non-elected claims, the Examiner will search the same classes of art as is required to search the invention of the elected claims, resulting in the same references being cited against both of the aforementioned groups of claims.

Thus, this restriction will not reduce the workload of the U.S. Patent and Trademark Office or simplify prosecution of the application. As set forth in M.P.E.P. Section 803, there are two criteria for a proper restriction requirement between patentably

distinct inventions: (1) the inventions must be independent or distinct as claimed; and (2) there must be a **serious burden** on the Examiner if restriction is not required. This portion of the M.P.E.P. requires that if the search and examination of an entire application can be made without serious burden, the Examiner **must** examine it on the merits, even though it includes claims to distinct or independent inventions.

On page 3 of the Office Action, claims 1-15 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. This portion of the Office Action objects to the term "publishing" on a file server as recited in claim 1. This objection is respectfully traversed, as the specification describes exemplary embodiments wherein an entity can prepare and issue content onto a server for public distribution. For example, any entity which places content (e.g., a banner file or a web site) on a server can be considered a publishing entity (see, for example, specification page 6, lines 14-24). As such, use of the term "publishing" in claim 1, is accurate and definite and withdrawal of this objection is requested.

On page 4 of the Office Action, claims 1-4 and 6-14 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,141,010 (Hoyle). On page 5, claims 1-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Hoyle patent. In addition, claims 1-14 are rejected as being unpatentable over the combination of the Hoyle patent with U.S. Patent No. 6,317,784 (Mackintosh et al). Finally, in the last paragraph on page 5, through the first paragraph on page 6, claims 1-14 are rejected as being unpatentable over U.S. Patent No. 6,118,449 (Rosen et al). All of the foregoing rejections are respectfully traversed, as none of the patents relied upon by the Examiner, considered

individually, or in the combination set forth in the Office Action, teach or suggest Applicant's invention as set forth in independent claim 1.

The present invention is generally directed to a continual and integrated approach to Internet banner display rights, coupled with a multi-function banner that is configurable by a user. Figure 1 shows an exemplary networked computer system wherein communication devices 10 are connected to servers 12 by a communication network 14 such as the Internet. To view content and interact with the services provided by the servers, the devices 10 run a browser application program 16. Available content and services are stored at the servers 12. By entering a particular address in a browser application, the user can be presented with a page of information stored at a particular server.

An exemplary banner, comprising a portion of a web page from one site that receives content from a different site, is illustrated in Figure 2. In Figure 2, a web page 20 of web publisher ABC, Inc., whose web site may be hosted on a first server 12a, is illustrated. A banner 24 associated with a different web site XYZ Corp., may be hosted on a different server 12c. Instructions within the code for web page 20 are used to display the banner, and include a reference to the source of information for the banner (e.g., an address associated with server 12c), at which a file containing additional code for specifying contents of the banner 24 are resident.

As shown in Figure 3, an exemplary banner can provide access to multiple different services and thereby function as a multi-site/multi-function portal for the user. As shown therein, the exemplary banner 24a includes a menu 30 for affording the user access to

various categories of content available through the party which has acquired the right to display and control the contents of the banner.

The foregoing features are broadly encompassed by independent claim 1, which is directed to a method for providing multiple types of content for users of the Internet. Claim 1 recites a step of publishing at least one file on at least one file server that provides Internet users with access to a plurality of different types of information and services. Claim 1 further recites establishing a connection between said file and at least one web page that is displayed at an Internet web site; and causing at least some of the contents of said file to appear within a banner whenever a user downloads said page from the display.

None of the documents relied upon by the Examiner teach or suggest such a combination of features. For example, none of the documents relied upon teach or suggest the claim 1 step of establishing a connection between a file published on at least one file server and at least one web page displayed at an Internet web site, such that contents of the file appear within a banner when a user downloads the web page. To the contrary, systems and methods described in the patents relied upon, at best, are directed to a transfer of information from a server to an end user (e.g., to the desktop computer of an end user), and are not directed to establishing a connection between at least one file and at least one file server with a web page displayed at an Internet web site.

Referring to the Hoyle patent, the abstract describes providing an automatically upgradable software application that includes targeted advertising. The software application is described as a graphical user interface that includes a display region for banner advertising downloaded over the Internet. The software application is described as

being accessible from the server via the Internet. According to the Hoyle patent, the user acquires software over the Internet, which then becomes resident on the user's machine. Banner advertising information can then be sent directly to the user. Thus, rather than establishing a connection between a file containing banner advertising and at least one web page displayed at an Internet web site, the Hoyle patent is directed to creating a direct link between an end user and an entity which provides banner advertising.

The foregoing distinction can be traced to a fundamental difference in the business model associated with the system of the Hoyle patent verses that of the present invention. In accordance with the Hoyle patent, end users constitute the customer base which would purchase the automatically upgradable software application that can communicate directly with banner advertisers. In contrast, exemplary embodiments of the present invention are directed to web site owners interested in interfacing their web site with multiple types of content to provide more content rich web pages to end users.

The remaining patents relied upon by the Examiner fail to overcome the deficiencies of the Hoyle patent. The Mackintosh patent is directed to a media player for playing broadcast material and associated supplemental information. The player includes a receiver configured to receive broadcast material from a broadcast service provider. As with the Hoyle patent, the Mackintosh patent is directed to creating a direct link between a broadcaster and end users, and precludes end users from controlling the request for material from a file accessed via a web page downloaded by the user for display. Thus, the Mackintosh patent, even when considered in combination with the Hoyle patent, fails to teach or suggest establishing a connection between a file on at least one file server, and at

least one web page that is displayed at an Internet web site, such that contents of the file appear within a banner downloaded by a user for display.

The Rosen patent is directed to modifying a curser image displayed on a remote terminal to a specific image having a desired shape and appearance. As with the Hoyle and Mackintosh patents, the system of the Rosen patent is directed to the creation of a direct link between information resident on a server and an end user. As such, the Rosen patent fails to teach or suggest establishing a connection between a file on at least one file server, and at least one web page displayed at an Internet web site, such that contents of the file appear within a banner when a user downloads the page for display.

Because the patents relied upon by the Examiner fail to teach or suggest Applicant's claim 1 combination of features, this claim is considered allowable. The remaining claims 2-14 recite additional advantageous features of the present invention and further distinguish over the documents relied upon by the Examiner.

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance and such allowance is respectfully solicited.

Respectfully submitted,

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